

Docket No.: BKNL-001-101
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Bruce Kneller

Application No.: 10/785,600

Confirmation No.: 3185

Filed: February 23, 2004

Art Unit: 1617

For: MODIFIED DELTA5-ANDROSTENES
HAVING IMPROVED BIOAVAILABILITY

Examiner: B. Badio

REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION

TO REVIVE APPLICATION UNDER 37 C.F.R. §1.137(a)

MS Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests reconsideration of the decision dated May 6, 2008 dismissing Applicant's petition to revive the subject application under 37 C.F.R. §1.137(a) filed on April 24, 2008 (hereinafter "Petition") because the delay in replying to the Office Action mailed from the U.S. Patent & Trademark Office (PTO) on May 3, 2007 was unavoidable by Applicant.

Applicant notes that a subsequently filed Petition to Revive Application Under 37 C.F.R. §1.137(b) (for unintentional abandonment) filed on May 13, 2008 was granted, and that the application has been returned to pending status. However, in view of the potential uncertainty regarding the U.S. Patent & Trademark Office's authority to grant such a petition in the wake of the decision in *Aristocrat Technologies Australia PTY Ltd. v. International Game Technology* (491 FSupp2d 916 (2007)), Applicant respectfully requests reconsideration of the dismissal of the Petition under 37 C.F.R. §1.137(a).

Dismissal

The decision dismissing the Petition states that the showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). Specifically the dismissal states that an application is unavoidably abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as, *inter alia*, the negligence of otherwise reliable employees, the response is not timely received in the Office (Ex parte Pratt, 1887 Decl Comm'r Pat. 31 (Comm'r Pat. 1887)). The decision further states that Applicant is bound by the consequences of the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant.

Request for Reconsideration

Courts that have considered this issue have generally held that circumstances which constitute "unavoidable delay" must be determined on a "case-by-case basis, taking all of the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538 (D.C.Cir.1982). As summarized by the MPEP (§711.03(c)), the courts have adopted a "reasonably prudent person" standard in determining if a delay was unavoidable. Specifically:

The word "unavoidable"...is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. MPEP §711.03(c)

Applicant respectfully submits that it is *exactly* the situation in the present case that unexpectedly and through unforeseen fault of a previously trustworth and reliable agent (Attorney Leavitt), an apparent failure to timely file a reply to the outstanding Office Action occurred. The Statement of Facts by Bruce Kneller filed with the subject Petition sets forth in detail the circumstances surrounding the apparent failure to timely file a Reply to the Office Action mailed from the PTO on May 3, 2007.

Applicant respectfully submits that he was diligent and careful in his original selection of Mr. Leavitt as his patent counsel, selecting a registered patent attorney personally known to him. In addition, during the years preceding Applicant's incarceration, Mr. Leavitt had represented Applicant in his patent matters without apparent incident. Accordingly, it was unforeseen and unexpected that Mr. Leavitt would forsake his duty of care to Applicant entirely and fail to act on Applicant's behalf in direct contradiction of Applicant's instructions, particularly given that Mr. Leavitt had knowledge of Applicant's incarceration and increased reliance on Mr. Leavitt's representation. **It is illogical to find unavailability in the unexpected failure of an employee of Mr. Leavitt (e.g., a mail clerk or secretary) while at the same time holding that an unexpected failure of Mr. Leavitt himself is avoidable vis-à-vis Applicant.** Clearly the abandonment of the subject application as a result of the apparent failure to timely file a reply to the outstanding Office Action was unavoidable by Applicant.

Moreover, Applicant did not learn of the abandonment of the subject application until advised by his new counsel (Ms. Treannie), as Mr. Leavitt did not advise Applicant that a reply had not been timely filed or forward the Notice of Abandonment to Applicant upon receipt from the PTO. Applicant notes that the record obtained from PAIR indicates that Mr. Leavitt also did not respond to inquiries from Examiner Badio regarding the status of the subject application.

Finally, as detailed in the Statement of Facts, Applicant took immediate action upon learning that the subject application had apparently been abandoned. Applicant's new counsel immediately attempted to obtain the file for the subject application from Mr. Leavitt, and, failing that, diligently prepared the concurrently submitted reply based on publicly available documents and consultation with Applicant. Under the circumstances of Applicant's incarceration and corresponding reduced availability for consultation, this process proceeded as quickly as possible. Applicant respectfully submits that the facts of the instant application are readily distinguishable from the facts of all of the cases cited in the dismissal in that there are no unexplained delays, and Applicant's incarceration adds further unavoidable restrictions on his communication and interaction with counsel. Accordingly, Applicant respectfully submits that the entire delay from the due date for reply to the filing of this Petition was unavoidable by Applicant.

Applicant believes that all requirements for a grantable petition under 37 C.F.R. §1.137(a) were met by the filing of the Petition on April 24, 2008, and Applicant respectfully urges the Commissioner to reconsider and grant this Petition without delay. Applicant believes that all fees required for this submission have been properly accounted for, but Applicant hereby authorizes the Commissioner to charge any additional fees which may be due or credit any overpayment to Deposit Account No. 50-3655 under Attorney Docket BKNL-001-101.

Dated: 7/7/08

Respectfully submitted,

By Lisa M. Treannie

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